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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,436	06/25/2003	Steven M. Burns	085.10940-US (03-325)	6928
34704 7590 10/29/2009 BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510			EXAMINER IP, SIKYIN	
			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			10/29/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/606,436

Applicant(s)

BURNS ET AL.

Examiner

Sikyin Ip

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-52 is/are pending in the application.
- 4a) Of the above claim(s) 48-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 34-47 are, drawn to a method for heat treating workpiece, classified in class 148, subclass 559+.
- II. Claims 48-52 are, drawn to a system for heat treating a coated workpiece, classified in class 266, subclass 144+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as surface hardening or the process as claimed can be practiced by another materially different apparatus such as peening.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Similar restriction was made on September 15, 2005. Applicant's election without traverse of Group I in the reply filed on September 26, 2005.

The Group II claims submitted with RCE request fail to comply 35 U.S.C. 132(b) which states "Applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions). See 37 CFR §1.145. Any newly submitted claims that are directed to an invention that is independent and distinct from the invention previously claimed will be withdrawn from consideration and not entered. See subsection VI. below. An RCE is not the filing of a new application. Thus, the Office will not convert an RCE to a new application such as an application filed under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d)." See MPEP §706.07(h) [R-2] Request for Continued Examination (RCE).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 is indefinite because of center of an area which the at least one workpiece is in the furnace is said furnace chamber, said subjecting step comprising

It is unclear "center of an area" of said furnace chamber or workpiece. Because more

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than one workpiece can be treated, the furnace chamber can be filled with workpieces. Thus, injecting gas where workpieces are in the furnace chamber reads on treating the entire furnace chamber.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 34-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6042898 to Burns et al in view of JP 62139810 (PTO-1449) or JP 2003027209 (PTO-1449).

Burns discloses steps of coating, diffusion heat treatment, peening, carbonizing, grit blasting, ionized gas cleaning, and coating. The features relied upon described above can be found in the reference(s) at: col. 3, line 31 to col. 4, line 37 and col. 6, example 2. Burns does not disclose step of cleaning a furnace, cleaning the workpiece during diffusion heat treatment step and gas flow rate. But, cleaning workpiece at any

step is contemplated within ambit of ordinary skill artisan when the workpiece is contaminated. With respect to the gas flow rate that it would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the gas flow rate in order to balance cost of gas and cleanness of the gas, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). However, JP 62139810 (abstract) or JP 2003027209 (abstract) teaches cleaning a furnace with inert gas in an vacuum furnace/chamber. Cleaning a furnace includes cleaning center of furnace. Treating gas is transported by a pipe (40) to center of the furnace (see JP 2003027209 drawings 1-3 and abstract). The gas transported pipe (40) reads on claimed manifold. JP 62139810 in abstract teaches to heat inside of the heat treatment furnace at temperature higher than heat treatment temperature in order to remove moisture and oil. Although specific temperature range has not been specified, it teaches temperature difference sufficient high to remove contaminants. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to clean a heat treatment furnace as taught by JP 62139810 or JP 2003027209 in order to improve/provide a clean furnace for heat treatment. *In re Venner*, 120 USPQ 193 (CCPA 1958), *In re LaVerne*, et al., 108 USPQ 335, and *In re Aller*, et al., 105 USPQ 233.

Response to Arguments

Applicant's arguments filed August 7, 2009 have been fully considered but they are not persuasive.

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Applicant argues that Burns et al fail to teach cleaning furnace chamber before heat treatment steps. But, cleaning contaminated furnace before heat treatment is contemplated within ambit of ordinary skill artisan.

~~There is no discussion of injecting a gas only at the center of~~

Applicant argues that " the location where workpieces are to be placed ~~at the center of~~ "

But, because more than one workpiece can be treated, the furnace chamber can be filled with workpieces. Thus, injecting gas where workpieces are in the furnace chamber reads on treating the entire furnace chamber.

Applicant argues that none of cited references teaches the claimed flow rate. But, applicants have not shown the claimed flow rate is critical or possessed unexpected result. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manipulate the flow rate in order to remove contaminants, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

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Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121 and 37 C.F.R. Part §41.37 (c)(1)(v).

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Thursday from 5:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sikyin Ip/
Primary Examiner, Art Unit 1793

October 26, 2009